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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047.307	01/15/2002	Thomas E. Murphy JR.	END920010094US1	5180
23550 7590 01/11/2008 HOFFMAN WARNICK & D'ALESSANDRO, LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207			EXAMINER LIVERSEDGE, JENNIFER L.	
			ART UNIT 3692	PAPER NUMBER
			NOTIFICATION DATE 01/11/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hwdpatents.com

# Office Action Summary

Application No.

10/047,307

Applicant(s)

MURPHY ET AL.

Examiner

Jennifer Liversedge

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received:

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 10/047,307 filed on October 15, 2007.

The amendment contains original claims: 4, 6-9, 11, 13-15, 18-21 and 23-26.

The amendment contains previously presented claims: 5 and 12.

The amendment contains amended claims: 1-3, 10, 16-17 and 22.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 10-12 and 16-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub. No. US 2003/0195811 A1 to Hayes, Jr. et al. (further referred to as Hayes).

Regarding claim 1, Hayes discloses a method for receiving an alert code in a commercial transaction (Figures 1, 2B, 2C, 3B-7; pages 1-6), comprising the steps of:

Using a transactional device in a commercial transaction (Figures 1, 2B, 4C—5B, 6A-7; pages 1-6); and

Receiving an alert code attached to transaction data for the commercial transaction indicating receipt of a message from a third party sender that is not involved in the commercial transaction (Figures 2B- 2C, 3B-7; pages 1-6).

Regarding claim 10-12, Hayes discloses a method, system and program product for receiving an alert code in a commercial transaction (Figures 1, 2B, 2C, 3B-7; pages 1-6), comprising the steps of:

Contacting a message center with a message from a third party sender that is not involved in the commercial transaction (Figures 1, 2B, 2C, 3B-7; pages 1-6);

Using a transactional device in a commercial transaction (Figures 1, 2B, 4C—5B, 6A-7; pages 1-6);

Identifying an intended recipient of the message (Figures 1, 2A-2C, 3B-7; pages 1-6);

Attaching an alert code to transaction data for the transaction (Figures 2B-2C; pages 1-6);

Receiving the alert code attached to the transaction data, wherein the alert code is unrelated to the transaction (Figures 2B- 2C, 3B-7; pages 1-6); and

Retrieving the message in response to the received alert code (Figures 2B- 2C, 3B-7; pages 1-6).

Regarding claims 2-5, Hayes discloses contacting a message center with the message prior to the using of the transactional device and receiving a transaction request after the using of the transactional device; attaching an alert code to transaction data in response to the transaction request; sending the alert code attached to the transaction code; retrieving the message from the third party via the message center in response to the received alert code by contacting the message center and providing a unique identifier (Figures 1, 2B, 2C, 3B-7; pages 1-6).

Regarding claim 6, Hayes discloses where in the transactional device is selected from the group consisting of a magnetic device and a machine-readable code containing device (Figure 5B-5E).

Regarding claim 7, Hayes discloses wherein the alert code is unrelated to the commercial transaction (Figures 1, 2B, 2C, 3B-7; pages 1-6).

Regarding claim 16, Hayes discloses alerting a transaction clerk of the contact (page 6, paragraph 56).

Regarding claims 17, 19, 22 and 24, Hayes discloses a system and program product stored on a recordable medium for receiving an alert code in a commercial transaction (Figures 1, 2B, 2C, 3B-7; pages 1-6), comprising:

A message reception system for receiving a message from a third party sender that is not involved in the commercial transaction (Figures 1, 2B, 2C, 3B-7; pages 1-6);

A recipient identification system for identifying an intended recipient of the message based upon use of a transactional device during a commercial transaction (Figures 1, 2A-2C, 3B-7; pages 1-6);

An attachment system for attaching an alert code to transaction data for the transaction (Figures 2B-2C; pages 1-6); and

A message transmission system for transmitting the received message (Figures 2B- 2C, 3B-7; pages 1-6).

Regarding claims 18 and 23, Hayes discloses wherein the message reception system records the message, and wherein the message transmission system plays the recorded message (Figures 5B-5E; page 4, paragraph 46).

Regarding claims 20 and 25, Hayes discloses wherein the alert code is unrelated to the transaction (Figures 2B- 2C, 3B-7; pages 1-6)

Regarding claims 21 and 26, Hayes discloses a subscription system and program product for the intended recipient to subscribe to a message service (page 2, paragraph 31; page 3, paragraph 32).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8-9 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes as applied to claims 1 and 10 above, and further in view of case law (In re Kuhle, 526 F.2d 553, 188 USPQ7 (CCPA 1975)).

Hayes does not disclose wherein the alert code is appended, prepended or embedded to or in a transaction code. However, it would be obvious to one of ordinary skill in the art to place the alert code in either of an appended, prepended or embedded

location relative to the transaction code. For example, in the Kuhle case, the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice. Applicant has offered no specific reasoning as to why it is critical that the alert be placed in the appended, prepended or embedded location and Examiner holds that it is therefore obvious to place it in any relative location.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes as applied to claim 10 above, and further in view of Warmack.

Hayes does not disclose wherein the transactional device is a magnetic device. However, Warmack discloses wherein the transactional device is a magnetic device (pages 1-5). It would be obvious to one of ordinary skill in the art to modify the message system by transaction activation mechanism as disclosed by Hayes to adapt the use of credit cards as a transactional device as disclosed by Warmack. The motivation would be that frequently credit cards are included in PDAs, phones, etc. and as Warmack notifies when a credit card is used, Hayes knows when a system is on-line and can send notification as to that information. Accordingly, integrating the use of credit cards as disclosed by Warmack with the system as disclosed by Hayes would enable messages to be sent when a device and its components are in active mode.

### ***Response to Arguments***

Applicant has argued that Hayes fails to teach receipt of a message from a third party sender that is not involved in the commercial transaction, as presented in the



current amendment to the claims. However, Hayes discloses the transmittal and receipt of messages from third party senders that are not involved in a transaction, such as the sending of news and weather messages and alerts sent by various content providers (Figure 5B), and wherein the messages are sent to subscribers in a real-time, interactive mode (page 1, paragraph 8) via a central message center which is contacted with the messages and alerts (page 2, paragraph 27).

Applicant has further argued the use of "unsubstantiated factual references" for the assertion that it would be obvious that an alert could be appended or prepended to the transaction code. Examiner reiterates that the rejection was made using the prior art of Hayes, and further in view of case law. The examiner does not believe that case law would be most aptly categorized as "unsubstantiated factual references". Rather, the case law stated, *In re Kuhle*, 526 F.2d 553, 188 USPQ7 (CCPA 1975), taught that the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice. Applicant has offered no specific reasoning as to why it is critical that the alert be placed in the appended, prepended or embedded location and Examiner holds that it is therefore obvious to place it in any relative location. Applicant states that the Hayes messages are textual and appending or prepending a message would confuse the meaning of the message. However, it is unclear how the attaching of any message format would prove any more confusing than another. If a transactional device user is a subscriber to a messaging/alert service, the user would be expecting the receipt of messages and a message from a party unrelated to a transaction should differentiate itself from other content related to a transaction.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

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**KAMBIZ ABDI**  
SUPERVISORY PATENT EXAMINER